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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10004465-1

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on 9/29/05

Signature

Typed or printed name

Doreen Melchior

Application Number

09/814,301

Filed

3/21/01

First Named Inventor

Binnus Al-Kazily

Art Unit

2152

Examiner

Trong N. P. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 38,520☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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September 29, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---------------------------------|---|--------------------------------|
| In re application of: |) | Examiner: Trong Nhan P. Nguyen |
| Binnus Al-Kazily |) | |
| Serial No.: 09/814,301 |) | Art Unit: 2152 |
| Filed: March 21, 2001 |) | |
| For: LOCATION BASED INFORMATION |) | |
| DELIVERY |) | |
| Date of Last Office Action: |) | Attorney Docket No.: |
| June 29, 2005 |) | 10004465-1 |
| Date of Advisory Action: |) | |
| September 19, 2005 |) | |

September 29, 2005

**PRE-APPEAL BRIEF REQUEST FOR REVIEW,
CLAIM AMENDMENTS, and
ACCOMPANYING ARGUMENTS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests a Pre-Appeal Brief Review for the final rejection of the present application. The present request includes accompanying arguments and is being filed with a Notice of Appeal.

CERTIFICATE OF MAILING

Date of Deposit: September 29, 2005

I hereby certify that these papers are being deposited with the United States Postal Service with sufficient postage as "First Class Mail in an envelope addressed to: Mail Stop AF, The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Doreen Melchior
DOREEN MELCHIOR.

Amendments to the Claims:

Status of Claims:

Claims 5-7, 9-14, 16-20 are pending for Appeal after the present amendment.

Claims N/A are added by the present amendment.

Claims 1-4, 8, 15 are canceled by the present amendment.

Claims 5 and 18 are in independent form.

1-4. (Canceled).

5. (Currently Amended) A method for delivery of electronic mail messages ~~information~~ to a destination in a communications network based on a physical location of a mobile unit, comprising:

determining the physical location of the mobile unit based on one or more cellular signals transmitted by the mobile unit to a first communications network that is a cellular network, the mobile unit being associated to a cellular account;

determining a network address of a networked device that is in proximity to the physical location of the mobile unit based on the one or more cellular signals; and

identifying an electronic mail account using the one or more cellular signals; and

submitting a request to a second communications network that handles electronic mail to forward electronic mail messages ~~information~~ relating to ~~an~~ the electronic mail account to the network address, ~~the electronic account and the network address being determined based on said one or more signals.~~

6. (Currently Amended) The method of claim 5, further comprising:

in response to the request, forwarding electronic mail messages ~~information~~ relating to the electronic mail account to the network address.

7. (Currently Amended) The method of claim 6, further comprising:

delivering the electronic mail messages ~~information~~ forwarded to the network address to a point of delivery.

8. (Canceled).

9. (Currently Amended) The method of claim 5 ~~[[8]]~~, wherein the mobile unit is a cellular telephone.

10. (Original) The method of claim 5, wherein the second communications network is a computer network.

11. (Currently Amended) The method of claim 10, wherein the computer network includes a server for servicing the submitted request for the electronic mail account.

12. (Original) The method of claim 11, wherein the server is an electronic mail server.

13. (Original) The method of claim 10, wherein the network address is determined by finding the best match between the network addresses available at or near the physical location.

14. (Previously Presented) The method of claim 13, wherein the network address is an IP address of a server at or near the physical location.

15. (Canceled).

16. (Original) The method of claim 7, wherein the point of delivery is a printer server.

17. (Currently Amended) The method of claim 7, wherein the point of delivery is a device that can display the electronic mail messages ~~information~~.

18. (Currently Amended) A system for delivering electronic information to an address in a computer network based on ~~the~~ a physical location of a cellular transmitter, said system comprising:

logic code configured for execution by a processor, wherein execution of the logic code can cause the system to perform the following acts:

determine a physical location of a cellular transmitter based on one or more cellular signals transmitted by the cellular transmitter;

identify an electronic mail account based on said one or more cellular signals;

locate a network address of a proximity device whose location ~~that~~ best matches the physical location of the cellular transmitter; and

submit a request to a server servicing the electronic mail account to forward electronic mail ~~information~~ stored on the server for the electronic mail account to the network address of the proximity device.

19. (Previously Presented) The system of claim 18, wherein said server, in response to receiving the request, forwards a requested information to the network address.

20. (Original) The system of claim 19, wherein said requested information includes electronic messages.

Accompanying Arguments for Review

Applicant respectfully requests a Pre-Appeal Brief Review for the Final Rejection that was issued June 29, 2005. The present Accompanying Arguments are less than five pages.

Summary of The Final Office Action

Claims 1-3, 5-11, 13-14, and 16-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nagendran, 6,731,940.

Claims 4, 12, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nagendran in view of Tari et al, 6,704,295.

Present Amendment

Applicant respectfully requests entry of the present amendment because it cancels claims 1-4, 8 and 15 and reduces issues for appeal. As explained below, the §102 rejection is eliminated by the present amendment, which leaves only the §103 rejection as an issue. The term “a user” is not included in claim 5 thus the Examiner should be satisfied that no new limitations have been added.

35 U.S.C. §102(e) Rejections

Independent claims 5 and 18 have been amended to recite electronic mail features of various dependent claims such as claims 4, 12, and 15. Thus, no new matter has been added. Since claims 4, 12, and 15 were rejected under §103 based on the combination of Nagendran in view of Tari, the §102(e) rejection based on Nagendran should now be overcome. The present arguments will thus focus on the §103 rejection. A detail explanation of Nagendran in view of the claims can be found in Applicant’s response dated October 25, 2004 at pages 8-11.

35 U.S.C. 103(a) Rejection

Independent Claim 5

Independent claim 5 has been amended to clarify that the mobile unit is associated to a cellular account and that the electronic mail account is a separate account. Claim 5 includes identifying an electronic mail account using the one or more cellular signals. Other amendments have been made to claim 5 as seen in the claim.

The Office Action states that Nagendran does not teach a system that includes electronic mail messages but cites Tari as showing an email system that sends email messages to a mobile device (col. 7, lines 32-49). Applicant respectfully submits that combining Tari with Nagendran still fails to teach or suggest claim 5.

For example, column 7, lines 32-49 (and other sections) of Tari, describe a system that functions oppositely from the claimed method and oppositely from Nagendran. In general, Tari describes a system that monitors emails for a subscriber group and then sends the email to their mobile terminal. The mobile terminal is not involved in the process except for being the receiving device. Thus, Tari does not forward email messages based on signals from the mobile terminal. Signals from the mobile terminal are not involved in or part of the process in Tari.

This is opposite from the present claim 5 since the claimed method initiates with the cellular signals from the mobile unit and the method operates based on the cellular signals from the mobile unit. Mail messages can then be forwarded to a network device that is in proximity to the mobile unit. The network device is also determined based on the cellular signals as recited in claim 5.

Additionally, Tari requires “a table that relates account information of mails and identifier information of the mobile terminal 104-n...” (column 7, lines 45-48). Thus, it is easy for Tari to send an email to a mobile terminal because the email is sent directly to the mobile terminal (e.g. call the mobile terminal). This is different from the claimed method where the

mail messages are not sent to the mobile terminal, but are sent to a networked device (e.g. destination device) that is in proximity to the physical location of the mobile unit. The destination device will not be a constant device since it will change as the mobile unit moves. Tari, conversely, always sends the email to the mobile terminal, a constant destination device.

Tari teaches sending emails directly to a mobile terminal. Thus, modifying Nagendran with Tari would allow Nagendran to send emails to a mobile device, which as explained above, fails to teach or suggest the present claims. There is no suggestion for a different type of modification.

Applicant will assume that the Examiner will use Tari to teach sending emails to a nearby device like the public display (e.g. electronic billboard) of Nagendran. This, however, is not suggested by the references and one of ordinary skill in the art would have no motivation to make such a modification. The reason is privacy. One of ordinary skill would not be motivated to have their personal email messages posted on a public electronic billboard for the world to see. Therefore, such a modification is not suggested and the combination of Nagendran and Tari still fails to teach or suggest present claim 5.

As for the “Judicial Notice” of the Office Action that Nagendran inherently verifies the account information of the mobile device, the present amendment makes this Notice moot since the claims differentiate between a cellular account and an electronic mail account. However, Applicant reasserts that the Judicial Notice is not supported by the references since Nagendran does not verify account information and not all providers verify account information. Websites like cnn.com and msn.com provide information without account verification.

Since claim 5 recites features not taught or suggested by the references, claim 5 patentably distinguishes over the references. Accordingly, dependent claims 6, 7, 9-14, 16 and 17 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 18

Claim 18 has been similarly amended as claim 5. In view of the explanations of the references above, the combination of Nagendran and Tari fails to teach or suggest present claim 18 and claim 18 is now in condition for allowance.

Conclusion

For the reasons set forth above, **claims 5-7, 9-14, 16-20** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

SEPT. 29, 2005

Date

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